

REMARKS

This Amendment is submitted in response to the Office Action dated December 4, 2001. In the Office Action, the Patent Office acknowledged Applicant's election of Group I, Claims 1-16 in Paper No. 4 and treated the election without traverse according to MPEP §818.03(a). The Patent Office objected to the submitted Drawings for failure to comply with 37 CFR §1.84(p)(4) because reference characters "30" and "390" were both used to designate a "backing sheet". The Patent Office rejected Claims 4-6 under 35 U.S.C. §112, second paragraph, because Claims 4-6 recite the limitation "the envelope" in line 1 without sufficient antecedent basis for the limitation. The Patent Office rejected Claims 1-11 and 13-16 under 35 U.S.C. §103(a) as being unpatentable over *Coats et al.* (U.S. Patent No. 5,624,069.)

Applicant notes with appreciation that the Patent Office indicated Claim 12 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Accordingly, Applicant added new Claim 21 which Applicant submits is allowable. Notice to that effect is requested.

By the present amendment, Applicant amended the Specification and Claims 1, 4-6 and 9. Applicant submits that the above amendments overcome the objection and rejections by the Patent Office for the reasons that follow and that the application is now

in condition for allowance. Notice to that effect is requested.

As to the objection to the Drawings under 37 CFR §1.84(p)(4) because reference characters "30" and "390" have both been used to designate a "backing sheet", Applicant amended the Specification such that "backing sheet" is designated by the reference character "30." Applicant submits that the amendment to the Specification overcomes the objection to the drawings by the Patent Office. Notice to that effect is requested.

As to the rejection of Claims 4-6 under 35 U.S.C. §112, second paragraph, Applicant amended Claims 4-6 by replacing the word "envelope" in each claim with the word "compartment" in each claim. Applicant submits that the rejection of Claims 4-6 has been overcome by the amendment. Notice to that effect is requested.

As to the rejection of Claims 1-11 and 13-16 under 35 U.S.C. §103(a), Applicant amended Claims 1 and 9. Applicant submits that the rejection of Claims 1-11 and 13-16 have been overcome by the amendments to Claims 1 and 9 for the reasons that follow.

Amended Claim 1 requires a mailing assembly for use in connection with the non-domestic delivery of a mailpiece holding contents for delivery thereof comprising a backing sheet that forms a compartment to be adhered to the mailpiece. Claim 1 further requires a mailing form with no adhesive backing wherein the mailing form is removably attached to the backing sheet. The mailing form is variably printed with information necessary to

comply with requirements for delivery of the mailpiece. The mailing form is inserted into the compartment to effect non-domestic delivery of the mailpiece.

Amended Claim 9 requires a mailing assembly for use in connection with non-domestic delivery of a mailpiece comprising a backing sheet that forms an envelope having a compartment. The envelope is adhered to the mailpiece. Claim 9 further requires a mailing form with no adhesive backing wherein the mailing form is removably attached to the backing sheet. The mailing form is subdivided into a plurality of sub-parts. Each sub-part is variably printed with information necessary to comply with requirements for non-domestic delivery of the mailpiece. At least one sub-part of the plurality of sub-parts is inserted into the compartment.

On the contrary, *Coats et al.* teach an envelope assembly that attaches to a mailpiece and receives various documents. The documents inserted into the envelope assembly taught in *Coats et al.* are not part of the envelope assembly. Rather, the documents must be obtained outside and apart from the envelope assembly. The indicia located on the envelope assembly is not inserted into the envelope compartments taught by *Coats et al.* In fact, the indicia located on the envelope assembly are stickers and adhesive backed labels used in the shipping process and for providing instructions on using the envelope assembly. These stickers and labels are not

provided for use as shipping documents to be placed inside the envelope assembly.

Regarding Claim 1, *Coats et al.* do not teach a backing sheet and a mailing form with no adhesive backing wherein the mailing form is removably attached to the backing sheet and further wherein the mailing form is inserted into the compartment as required by Claim 1 of the present invention. Regarding Claim 9, *Coats et al.* do not teach a backing sheet and a mailing form with no adhesive backing wherein the mailing form is removably attached to the backing sheet. *Coats et al.* do not teach a backing sheet and a mailing form wherein the mailing form is subdivided into a plurality of sub-parts and at least one of the plurality of sub-parts is inserted into the compartment as required by Claim 9 of the present invention.

The Patent Office provided absolutely no teaching whatsoever as to why one having ordinary skill in the art would have modified *Coats et al.* as applied in the Office Action in the rejection under 35 U.S.C. §103(a) by providing a mailing assembly as required by the present invention. Moreover, a person of ordinary skill in the art would never have been motivated to modify *Coats et al.* in the manner suggested by the Patent Office in formulating the rejections under 35 U.S.C. §103(a). Applicant respectfully submits that amended Claims 1 and 9 distinctly define the present invention from *Coats et al.*.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all of the teachings of the reference in its entirety, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

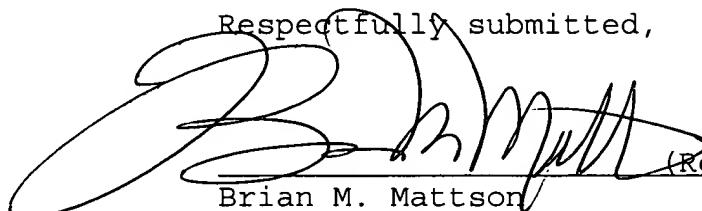
In view of the foregoing remarks and amendments, Applicant respectfully submits, the rejection under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

Claims 2-8 depend from Claim 1; and Claims 10-15 depend from

Claim 9. These claims are further believed allowable over the reference of record for the same reasons set forth with respect to their parent claims since each sets forth additional structural elements of Applicant's mailing assembly.

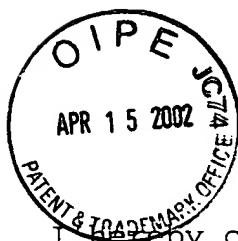
In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,



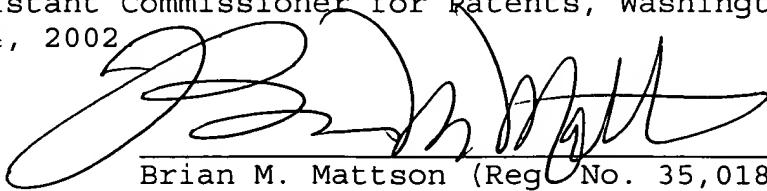
(Reg. No. 35,018)

Brian M. Mattson
Patents+TMS
A Professional Corporation
1914 North Milwaukee Ave.
Chicago, IL 60647
(773) 772-6009
ATTORNEY FOR APPLICANT



CERTIFICATE OF MAILING

I hereby certify that this **AMENDMENT** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D. C. 20231 on April 4, 2002



Brian M. Mattson (Reg. No. 35,018)

VERSION WITH MARKS TO SHOW CHANGES MADE

IN THE SPECIFICATION:

Please amend the first full paragraph starting on page 13 of the Specification, also identified as the eleventh paragraph of the DETAILED DESCRIPTION OF THE PRESENTLY PREFERRED EMBODIMENTS as follows:

Looking now at Figure 5, a bottom edge of the mailing assemblies from Figure 4 is shown. Here it may be more clearly observed that the adhesive layer 31 of the mailing assembly 1 is disposed only between [he] the mailing label 3 and the backing sheet [390] 30 and not between the receipt card 4 and the backing sheet 30. Such is the case for all similar mailing assemblies 40, 50, etc. Also, as described in connection with Figure 4, the first mailing assembly tear line 32 may perforate the entirety of both the mailing assembly 1 and the mailing assembly 40 including their respective backing sheets 30 and 41. Similarly, the second mailing assembly tear line 33 may perforate both the backing sheet 30 and the third backing sheet 51. Conversely, the mailing form tear line 5 of the mailing assembly 1 does not perforate the associated backing sheet 30 but only the associated mailing label 3 and the receipt card 4. Such design ensures that individual mailing assemblies which are provided on a reel or roll may be individually detached from the remaining mailing assemblies with relative ease and without fear of accidental separation of a mailing label from its associated receipt card.

IN THE CLAIMS:

Please amend Claim 1 as follows:

1. (Amended) A mailing assembly for use in connection with a non-domestic delivery of a mailpiece holding contents for delivery thereof, the assembly comprising:

 a backing sheet wherein the backing sheet [is capable of forming] forms a compartment to be adhered to [a] the mailpiece; and

 a mailing form with no adhesive backing wherein the mailing form is removably attached to the backing sheet[,] and further wherein the mailing form is variably printed with information necessary to comply with requirements for delivery of the mailpiece wherein the mailing form is inserted into [capable of fitting within] the compartment to effect non-domestic delivery of the mailpiece.

Please amend Claim 4 as follows:

4. (Amended) The mailing assembly of Claim 2 wherein the compartment [envelope] formed from the backing sheet is capable of adhering to the mailpiece via the adhesive layer.

Please amend Claim 5 as follows:

5. (Amended) The mailing assembly of Claim 2 wherein the compartment [envelope] formed from the backing sheet is capable of being formed via the adhesive layer.

Please amend Claim 6 as follows:

6. (Amended) The mailing assembly of Claim 1 wherein the

compartment [envelope] formed from the backing sheet is transparent.

Please amend Claim 9 as follows:

9. (Amended) A mailing assembly for use in connection with non-domestic delivery of a mailpiece, the assembly comprising:

a backing sheet wherein the backing sheet [is capable of forming] forms an envelope [to be] having a compartment wherein the envelope is adhered to the mailpiece; and

a mailing form with no adhesive backing wherein the mailing form is removably attached to the backing sheet wherein the mailing form is subdivided into a plurality of sub-parts wherein each sub-part is variably printed with information necessary to comply with requirements for non-domestic delivery of the mailpiece and further wherein at least one of the plurality of sub-parts is inserted into the compartment.

Please add Claim 21:

21. A mailing assembly for use in connection with non-domestic delivery of a mailpiece, the assembly comprising:

a backing sheet wherein the backing sheet is capable of forming an envelope to be adhered to the mailpiece;

a mailing form removably attached to the backing sheet wherein the mailing form is subdivided into a plurality of sub-parts wherein each sub-part is variably printed with information necessary to comply with requirements for non-domestic delivery of the mailpiece; and

an adhesive layer disposed on the backing sheet wherein the envelope formed from the backing sheet is formed via the adhesive layer on the backing sheet.